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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 09/777,987 Confirmation No. : 3216
First Named Inventor : Michael SPENCER
Filed : February 6, 2001
TC/A.U. : 3693
Examiner : Jason M. BORLINGHAUS

Docket No. : 102636.58039US
Customer No. : 23911

Title : Method of Using a Computerized Trading System to
Process Trades in Financial Instruments

PETITION TO WITHDRAW FINALITY UNDER 37 C.F.R. § 1.181

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully submits that the Office Action issued on November 16, 2006, was made final prematurely, and accordingly, the finality of this Office Action should be withdrawn.

M.P.E.P. § 706.07(a), discussing when an Office Action may be made final, states that such actions:

shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

It is respectfully submitted that the new grounds of rejection in the Office Action issued on November 16, 2006, was not necessitated by Applicants'

amendment and was not based on information submitted in an Information Disclosure Statement filed during the period set forth in 37 C.F.R. § 1.97(c).

The Office Action issued on November 16, 2006, rejects claim 1 under 35 U.S.C. § 112, second paragraph for indefiniteness. Specifically, the Office Action states that the recitation of the phrase “where possible” renders claim 1 indefinite. This phrase was recited in claim 1 as filed. Specifically, claim 1 as filed recited “(c) a trading administrator using the trading system computer apparatus to... match *where possible* the compared offers for sale and bids for purchase.” (emphasis added).

Because the phrase “where possible” was part of claim 1 as filed, the rejection of claim 1 for reciting this phrase was not necessitated by Applicants’ amendment of the claims. This language in claim 1 was not the basis of any previous rejection, and therefore, the indefiniteness rejection of this claim is a new grounds of rejection. Accordingly, by introducing the new grounds of rejection to claim 1 under 35 U.S.C. § 112, second paragraph, the Office Action issued on November 16, 2006, cannot be properly made final, and the finality of this Office Action should be withdrawn.

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Attorney Docket No. 102636.58039US
Reply Dated: December 1, 2006
Petition to Withdraw Finality

It is believed that no fees are due for this petition. However, if fees are required this paper should be considered as an authorization to charge Deposit Account No. 05-1323 (Docket #102636.58039US) for such fees.

December 1, 2006

Respectfully submitted,



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